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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,774	02/25/2002	Gregory P. Fitzpatrick	BOC9-2001-0002 (238)	4419

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AKERMAN SENTERFITT  
P. O. BOX 3188  
WEST PALM BEACH, FL 33402-3188

EXAMINER
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BRINEY III, WALTER F

ART UNIT	PAPER NUMBER
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2646

DATE MAILED: 11/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/082,774

Applicant(s)

FITZPATRICK ET AL.

Examiner

Walter F. Briney III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

It is noted herein that on 29 August 2005, the Office received a third Declaration from the third named inventor David Lebowitz, and thus, the previous remarks filed in the Advisory Action of 09 August 2005 concerning the Declarations have been rendered moot.

The Declarations filed on 01 August 2005 and 29 August 2005 under 37 CFR 1.131 have been considered but are ineffective to overcome the US patent Application Publication 2002/0061099 (herein Hayashi) reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Hayashi reference to either a constructive reduction to practice or an actual reduction to practice. Specifically, several gaps in time exist between correspondence from "undersigned outside counsel" and the response from the applicant. This raises doubt as to the due diligence on part of the applicant.

One particular gap is the substantially two-week period between 25 January 2002 and 8 February 2002. The outside counsel provided a draft on the former date, but the applicant required two weeks to file a response on the latter date. As this period of inactivity on part of the applicant (i.e. not on the part of the outside counsel, and hence not subject to the "first-in/first-out" workflow of the outside counsel as remarked by the applicant but not alleged by way of Declaration) has not been accounted for within the Declarations on file, there is an insufficient amount of evidence to show a

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continuum of due diligence during the critical period of right before the effective filing date of the reference (15 November 2001) and the date of reduction to practice (25 February 2002).

A second time gap exists between the dates of 18 February 2002 and the date of reduction to practice. During this substantially one-week period, the outside counsel transmitted correspondence on the former date, but there is no record of the applicant's activities before the latter date, i.e. the filing of the current application.

Because facts regarding the diligence of the applicant during the two above mentioned gaps have not been presented in form of either evidence or allegation of fact in a declaration, the Declarations under 37 C.F.R. § 1.131 are ineffective.

The above reasons for indicating that the Declarations are ineffective notwithstanding, the Declarations are ineffective because they fail to allege that the events relating to the conception coupled with due diligence leading to the reduction to practice of the instant invention occurred either in this country, NAFTA country or a WTO member country. See MPEP section 715.07(c) and 35 U.S.C. § 104.

In view of the above reasons indicating that the Declarations are ineffective at overcoming the Hayashi reference, the rejections of claims 1-20 relying on Hayashi are maintained herein.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 1, 2, 4-12, and 14-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hayashi et al. (US Patent Application Publication 2002/0061099).**

**Claim 1** is limited to a method of message delivery. Hayashi discloses an incoming call forwarding communication system. See Abstract. In one embodiment, depicted in figure 5, a caller (2) is enabled to contact a remote party (not shown) by of communication system (1) in a known manner. See paragraphs 67-69. Several, i.e. *plurality, reception states* are depicted in figure 3 in the rightmost column "STATE." The table associated with a subscriber number includes a plurality of forwarding destinations encapsulated with each *reception state* and a respective service mode that will be used during call forwarding, i.e. *wherein said reception states specify conditions for establishing communications links with receiving party addresses*. Some examples of service modes include voice, TV phone, and e-mail; i.e. communication is enabled *via at least one alternate communication channel different from a communication channel associated with a first initiated communications link between a sending party and the receiving party*.

With respect to the operation of the call forwarding communication system disclosed by Hayashi, figure 6 depicts receiving a call establishment request in step 41. Since the table shown in figure 3 is maintained for each subscriber on an individual basis, there is an inherent process for identifying the called subscriber number, i.e.

*identifying a receiving party address from the first initiated communications link.* Upon determining the called subscriber's identity, the process of figure 6 queries database (6) and determines the call forwarding destination information table as seen in figure 3, i.e. *determining reception state data specified by said plurality of reception states according to said receiving party address.* Hayashi discloses that the caller is presented with the table information. See paragraph 60, lines 12-15 and paragraph 74. Therefore, Hayashi anticipates all limitations of the claim.

**Claim 2** is limited to *the method of claim 1*, as covered by Hayashi. After receiving the table data of figure 3, the caller selects a type of call forwarding to be used to contact the called party in step 46, i.e. *receiving a response from the sending party specifying further instructions for processing said first initiated communications link.* See paragraph 74. Therefore, Hayashi anticipates all limitations of the claim.

**Claim 4** is limited to *the method of claim 3*, as covered by Hayashi. As stated in the rejection of claim 1, the table data provided to the caller at subscriber device (2) during step 45 of figure 6 is based on a database query using the dialed subscriber number received in step 41, i.e. *determining contextually relevant reception state data according to the communications channel over which said first initiated communications link is to be established.* Furthermore, data retrieval is based on the status of call forwarding at the time the call establishment request is received as indicated in step 42, i.e. *determining contextually relevant reception state data according to the time of said first initiated communications link.* Therefore, Hayashi anticipates all limitations of the claim.

**Claim 5** is limited to *the method of claim 1*, as covered by Hayashi. While not particularly addressed by Hayashi, the system inherently *completes* the call establishment request to the called subscriber, i.e. *completing said first communications link*, in a known manner in the even that call forwarding is disabled as determined in step 42 of figure 6. Therefore, Hayashi anticipates all limitations of the claim.

**Claim 6** is limited to *the method of claim 1*, as covered by Hayashi. In addition to completing calls as discussed in the rejection of claim 5, all telecommunication networks inherently have provisions for terminating calls, i.e. *terminating said first initiated communications link*. Therefore, Hayashi anticipates all limitations of the claim.

**Claim 7** is limited to *the method of claim 6*, as covered by Hayashi. As seen in figure 3, a plurality of service modes are available for contact forwarding. While Hayashi does not disclose a particular example of like communication channel forwarding, it is clear from the description of step 46 of figure 6 that the system of Hayashi allows a first and second communication request to be executed upon the same communication link. Specifically, the caller is allowed to select the contact forward destination from a plurality of different modes, such as e-mail and voice. Thus, a user of a cellular telephone (2) can attempt to contact a subscriber's cellular telephone at the number shown in the top-left of figure 3. Upon determination that call forwarding is on, the caller can then select to communicate with another cellular telephone of the subscriber, i.e. *initiating a second communications link to a different receiving party address using the same communications channel as said first initiated*

*communications link*. See paragraphs 70-77. Therefore, Hayashi anticipates all limitations of the claim.

**Claim 8** is limited to *the method of claim 6*, as covered by Hayashi. Paragraph 79 provides an example wherein a voice terminal is connected to a text terminal, and wherein the voice terminal input is converted into a form that is usable by the text terminal by a media converter (7), i.e. *initiating a second communications link using a communications channel different from the communications channel of said first initiated communications link*. Therefore, Hayashi anticipates all limitations of the claim.

**Claim 9** is limited to *the method of claim 1*, as covered by Hayashi. Clearly the system of Hayashi is not limited to providing call forwarding information to only one calling party. Subsequently, it *detects at least one additional initiated communications link from subsequent sending parties*. If the received communication initiation request is received at a time when call forwarding is enabled, as determined in step 42, the system will present forwarding information, i.e. *said reception state data*, to those callers that called at said time when call forwarding is enabled, i.e. *to selected ones of said subsequent sending parties*. Therefore, Hayashi anticipates all limitations of the claim.

**Claim 10** is limited to *the method of claim 1*, as covered by Hayashi. Clearly, if any party attempts to contact another subscriber of the network system disclosed by Hayashi, they will be provided with *reception state data* associated with that *third party* in the same manner as figure 6 discussed above. Therefore, Hayashi anticipates all limitations of the claim.



**Claims 11, 12, and 14-20** are directed toward a machine-readable storage with a program that executes the method that is essentially the same as claims 1, 2, and 4-10, as covered by Hayashi, respectively. The system disclosed by Hayashi includes a database (6) and service control apparatus (5), both of which are clearly computer instruction controlled devices. Therefore, Hayashi anticipates all limitations of the claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al. (US Patent Application Publication 2002/0061099) in view of Adams et al. (US Patent 6,631,186).**

**Claim 3** is limited to *the method of claim 1*, as covered by Hayashi. The system of Hayashi simply presents a list of forwarding addresses associated with a subscriber to a caller when the subscriber enables call forwarding. A detailed inspection of Hayashi indicates that there is no disclosure relating to *identifying a sending party address*. Therefore, there is no *determination of contextually relevant reception state data according to said identified sending party address and said receiving party address*.

Adams teaches a system and method for implementing and accessing call forwarding services. See Abstract. In general, a subscriber is enabled to control their call forwarding system in accordance with updated personal settings. One such setting is a priority screening list. See column 6, line 49 through column 7, line 9. The priority screening list contains numbers of caller numbers that will not be forwarded to a subscriber's registered forwarding telephone number. While neither Hayashi nor Adams discusses the advantages of call screening, the name given by Adams alone describes its utility. Specifically, priority screening means that only a caller of certain "high" priority will be able to contact a subscriber away from their primary number. Such an arrangement prevents telemarketers or other nuisance callers from disturbing a subscriber through forwarding from their primary number, in fact, some prior art systems that implement embodiments similar to the system of Adams are referred to as nuisance call blockers/screeners.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate provisions for caller number identification as taught by Adams for the purpose of reducing the volume of forwarded telephone numbers, which also results in a reduction of disturbance to a user from unsolicited or nuisance calls.

**Claim 13** is directed toward a machine-readable storage with a program that executes the method that is essentially the same as claim 3, as covered by Hayashi. The system disclosed by Hayashi includes a database (6) and service control apparatus (5), both of which are clearly computer instruction controlled devices. Therefore, Hayashi anticipates all limitations of the claim.

### ***Response to Arguments***

Applicant's arguments filed 29 August 2005 have been fully considered but they are not persuasive.

For a full treatment of why the remarks, the evidence and the Declarations are ineffective see the preceding section entitled Response to Amendments.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 August 2005 has been entered.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter F. Briney III whose telephone number is 571-272-7513. The examiner can normally be reached on M-F 8am - 4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WFB  
11/22/05



**SINH TRAN**  
**SUPERVISORY PATENT EXAMINER**